



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/694,992

10/29/2003

Toshiaki Ouchi

065905-0300

5302

22428

7590

05/03/2006

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

MORRISON, THOMAS A

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,992

Applicant(s)

OUCHI ET AL.

Examiner

Thomas A. Morrison

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 11 and 12, it is unclear how the type of sheet in these claims further limits the structure of the sheet feeder set forth in independent claims 4 and 9

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 3-4, 8-9 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Publication No. 7-76438.

Regarding independent claim 4, Figs. 1-7 show a sheet feeder (including 2 and 10) in an image forming apparatus (1) including

a manual sheet supply unit (11a) to supply a special sheet and an ordinary sheet, wherein the special sheet is stiffer and smaller in size than the ordinary sheet;

a conveying member (21) to convey the special sheet and the ordinary sheet supplied from the manual sheet supply unit (11a) toward an image forming process unit (e.g., an image recording part in the English Abstract); and

a sheet guide (30) provided between the manual sheet supply unit (11a) and the conveying member (21), having special sheet ribs (Figs. 5 and 6) to control both sides of the special sheet that is inserted and guided by the special sheet ribs (Figs. 5 and 6), and to guide the ordinary sheet by passing the ordinary sheet on an upper surface of the special sheet ribs (Figs. 5 and 6), wherein the sheet guide (30) further has a pressing member (50) between the special sheet ribs (Figs. 5 and 6) that supports a side of the ordinary sheet by pressing (Fig. 6), and descends by a weight of the special sheet when the special sheet is inserted between the special sheet ribs. By controlling the surface of the sheet in contact with the ribs, the whole sheet (i.e., both sides of the sheet) can be controlled. Regarding the recitation “a pressing member between the special sheet ribs that supports a side of the ordinary sheet by pressing, and **descends by a weight of the special sheet when the special sheet is inserted between the special sheet ribs**”, this bolded portion of the recitation has not been given any patentable weight in view of MPEP, section 2115. Likewise, the recitation of the special sheet being stiffer and smaller than the ordinary sheet has not been given any patentable weight in view of MPEP, section 2115. Specifically, MPEP, section 2115 states that, “[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims.” See MPEP, section 2115. Thus, it is the

Art Unit: 3653

examiner's position that all of the features of claim 4 are disclosed in Japanese

Publication No. 7-76438.

Regarding independent claim 9, Figs. 1-7 and the previously mailed detailed description of Japanese Publication No. 7-76438 disclose a sheet feeder in an image forming apparatus (including 2 and 10) including

a manual sheet supply unit (11a) to supply a special sheet and an ordinary sheet on a manual sheet supply tray (inside 11a), wherein the special sheet is stiffer and smaller in size than the ordinary sheet;

aligning rollers (21 in Fig. 21 and numbered paragraphs [0005] and [0009]) to align leading edges of the special sheet and the ordinary sheet supplied from the manual sheet supply unit (11a) and convey in the image forming direction (Fig. 7); and

a sheet guide (30) provided between the manual sheet supply unit (11a) and the aligning rollers (21), having special sheet ribs (Figs. 5 and 6) to control both sides of the special sheet and to guide the ordinary sheet by passing the ordinary sheet on upper surfaces of the special sheet ribs (Fig. 6), wherein the sheet guide (30) further has a pressing member (50) between the special sheet ribs (Figs. 5 and 6) that supports a side of the ordinary sheet by pressing, and descends by a weight of the special sheet when the special sheet is inserted between the special sheet ribs. As mentioned above, with regard to the recitation "a pressing member between the special sheet ribs that supports a side of the ordinary sheet by pressing, and **descends by a weight of the special sheet when the special sheet is inserted between the special sheet ribs**", this bolded portion of the recitation has not been given any patentable weight in view of

Art Unit: 3653

MPEP, section 2115. Likewise, the recitation of the special sheet being stiffer and smaller than the ordinary sheet has not been given any patentable weight in view of MPEP, section 2115. Specifically, MPEP, section 2115 states that, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." See MPEP, section 2115. Thus, it is the examiner's position that all of the features of claim 9 are disclosed in Japanese Publication No. 7-76438.

With regard to independent claims 4 and 9, even if the above noted operation of the pressing member according to the fed sheet is considered to have patentable weight, it is the examiner's position that Japanese Publication No. 7-76438 meets such limitations. In particular, Figs. 1 and 6 show the orientation of the pressing member (50) relative to the guide path for the sheets. When a sheet is conveyed by conveying member (21), such sheet will be inserted between the ribs (Fig. 6) and will move the pressing member (50) to the left in Fig. 1. In other words, the pressing member (50) will descend relative to the guide path (20) when such sheet is inserted between the ribs. The force applied to the sheet that causes the pressing member (50) to descend is equal to the mass of the sheet times the acceleration of the sheet ($F = ma$). The mass of the sheet is directly related to the weight of the sheet (i.e., $W = \text{mass} \times \text{gravity}$). As such, it is the examiner's position that the pressing member (50) between the special sheet ribs (Figs. 5 and 6) supports a side of the ordinary sheet by pressing (Fig. 6), and descends by a weight of the special sheet when the special sheet is inserted between the special sheet ribs, as claimed.

Regarding claims 3 and 8, Figs. 1 and 7 show that the manual sheet supply unit (11a) supplies the special sheet and the ordinary sheet in a horizontal direction, and the (conveying member (21)/aligning rollers (21)) convey the special sheet and the ordinary sheet in a vertical direction.

Regarding claims 11 and 12, MPEP, section 2115 states that, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." See MPEP, section 2115. As such, no patentable weight has been given to the special sheet being claimed as a postcard. As such, it is the examiner's position that all of the limitations of claims 11 and 12 are met by Japanese Publication No. 7-76438.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication No. 7-76438 as applied to claims 4 and 9 above, and further in view of U.S. Patent No. 6,102,393 (Kida et al.). Japanese Publication No. 7-76438 discloses that the pressing member (50) is made from plastic film, but does not specifically state that the pressing member (50) is polyester film.

The Kida et al. patent discloses that it is well known to provide a paper-handling device with paper guides (72) that are flexible, in that they are made from Mylar.

Art Unit: 3653

Moreover, the dictionary definition of "Mylar" is "A trademark for a thin strong polyester film". See page 780 of Webster's II New Riverside University Dictionary. It would have been obvious to one of ordinary skill in the art at the time of the invention, to provide the apparatus of Japanese Publication No. 7-76438 with a pressing member made from polyester, to ensure that the pressing member has sufficient flexibility characteristics, as taught by Kida et al.

Response to Arguments

4. Applicant's arguments with respect to claims 3-5 and 8-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

04/24/2006

A handwritten signature in black ink, reading "Kathy Matecki". The signature is written in a cursive, flowing style.

KATHY MATECKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600